

REMARKS

The specification has been amended to improve the clarity of the disclosure. In particular, **page 9, lines 7-26, and page 10, lines 1-12** have been amended to correct a number of previously undetected informalities. No new matter has been added.

Claims 3, 4, 9, 17, 19, 20 ,and 24-39 have been canceled.

Claims 1-2, 5-8, 10-16, 18, and 21-22 have been amended to further particularize the present invention.

Claim 23 remains unchanged.

New claims 40-51 have been added to more fully claim the invention.

All amendments and new claims are fully supported by the original disclosure. No new matter has been introduced.

Accordingly, claims 1, 2, 5-8, 10-16, 18, 21-23, and 40-51 are now pending.

Rejections under 35 U.S.C. §102(b)

Claims 1, 2, 5-8, 10-13, 22-26, 28, and 30-35 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,027,882, to Rosenberg ("Rosenberg").

Rejection of claims 24-26, 28, and 30-35 have been rendered moot by their cancellations.

Claims 1-2, 5-8, 10-13, and 22 have been amended to clearly distinguish the present invention over *Rosenberg*.

To establish a *prima facie* case of anticipation under 35 U.S.C § 102, the Examiner must identify where "**each and every facet of the claimed invention is disclosed in the applied reference.**" *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462

(Bd. Pat. App. & Interf. 1990), see also *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052, 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994).

Amended claim 1, among other limitations, requires the game board to have “a number of team spaces for selective occupancy by selected ones of the first and second plurality of tokens, and stochastic occupancy by the game piece, and at least a first of the team spaces having a first indicia indicating at least a selected one of an advantage movement and a disadvantage movement of the game piece that is dependant on the current occupancy state of the first team space, when the game piece lands in the first team space.”

Rosenberg fails to anticipate at least these required limitations. *Rosenberg* merely teaches of a plurality of player pieces for the player boards, where the player boards are separate and distinct from the game board (see at least col. 2, lines 48-60). *Rosenberg* does not teach providing indicia to the “spaces” to be occupied by the player pieces, indicating an advantage or a disadvantage movement of a game piece, that is based upon the current occupancy state of a particular “space” at the time a game piece lands on the particular “space”. Therefore, claim 1 is patentable over *Rosenberg*.

Claims 2, 5-8, 10-13 and 22-23 depend on claim 1, incorporating its limitations. Thus, for at least the above stated reasons, claims 2, 5-8, 10-13, and 22-23 are patentable over *Rosenberg*.

Claims 1-17, 21-36 and 39 stand rejected under 35 U.S.C. 102(b) as being anticipated by G.B. Patent No. 2060408 A, to Lewis (“Lewis”).

Rejection of claims 3, 4, 9, 24-36, and 39 have been rendered moot by their cancellations.

Claims 1-2, 5-8, 10-16, and 21-22 have been amended to clearly distinguish the present invention over *Lewis*.

To establish a *prima facie* case of anticipation under 35 U.S.C § 102, the Examiner must identify where "**each and every facet of the claimed invention is disclosed in the applied reference.**" *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990), see also *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052, 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994).

Amended claim 1, among other limitations, requires the game board to have "a number of team spaces for selective occupancy by selected ones of the first and second plurality of tokens and stochastic occupancy by the game piece, and at least a first of the team spaces having a first indicia indicating at least a selected one of an advantage movement and a disadvantage movement of the game piece that is dependant on the current occupancy state of the first team space, when the game piece lands in the first team space."

Lewis fails to anticipate at least these required limitations. *Lewis* merely teaches of a board game, where league tables are drawn on the board and of counters that are used (one per player) to advance around the board. The "markers" used in *Lewis* do not represent players, they merely represent a portion of a scoring means. (see at least page 2, col. 1, lines 51-53; and page 2, col. 2, lines 72-104). *Lewis* does not teach providing indicia to the "spaces" to be occupied by the player pieces, indicating an advantage or a disadvantage movement of a game piece, that is based upon the current occupancy state of a particular "space" at the time a game piece lands on the particular "space". Therefore, claim 1 is patentable over *Lewis*.

Claims 2, 5-8, 10-16, and 21-23 depend on claim 1, incorporating its limitations. Thus, for at least the above stated reasons, claims 2, 5-8, 10-16, and 21-23 are patentable over *Lewis*.

Claims 1-17, 21-36, and 39 stand rejected under 35 U.S.C. 102(b) as being anticipated by G.B. Patent No. 2139511 A, to Daniel Edward ("Edward").

Rejection of claims 3, 4, 9, 24-36 and 39 have been rendered moot by their cancellations.

Claims 1-2, 5-8, 10-16, and 21-22 have been amended to clearly distinguish the present invention over *Edward*.

As discussed earlier, to establish a *prima facie* case of anticipation under 35 U.S.C § 102, the Examiner must identify where "**each and every facet of the claimed invention is disclosed in the applied reference.**" *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990), see also *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052, 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994).

Amended claim 1, among other limitations, requires the game board to have "a number of team spaces for selective occupancy by selected ones of the first and second plurality of tokens and stochastic occupancy by the game piece, and at least a first of the team spaces having a first indicia indicating at least a selected one of an advantage movement and a disadvantage movement of the game piece that is dependant on the current occupancy state of the first team space, when the game piece lands in the first team space."

Edward fails to anticipate at least these required limitations. *Edward* merely teaches of use of markers (one per game player) to move around an annular path on the game board; the movement of the pieces correspond to spaces located on

the annular path that may affect the player's score (see at least page 1 of the Specification, lines 4-8). The game board has four tabular areas, not used by the markers, where cards representing players of a soccer team are placed facilitating the accumulation of points (see at least page 1 of the Specification, lines 36-41; and page 2 of the Specification, lines 11-13 and lines 40-58). *Edward* does not teach providing indicia to the "spaces" to be occupied by the player pieces, indicating an advantage or a disadvantage movement of a game piece, that is based upon the current occupancy state of a particular "space" at the time a game piece lands on the particular "space". Therefore, claim 1 is patentable over *Edward*.

Claims 2, 5-8, 10-16 and 21-23 depend on claim 1, incorporating its limitations. Thus, for at least the above stated reasons, claims 2, 5-8, 10-16, and 21-23 are patentable over *Edward*.

Rejections under 35 U.S.C. §103(a)

Claims 18-20, 37 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Lewis*.

Rejection of claims 19, 20, 37, and 38 have been rendered moot by their cancellations.

Claim 18 depend on claim 1, incorporating its limitations. Therefore, for at least the same reasons, claim 18 is patentable over *Lewis*, under 103.

New Claims 40-51

New claims 40-41 depend on claim 1, incorporating its limitations. Therefore, for at least the same reasons, claims 40-41 are patentable over the cited references.

New claim 42 includes the limitations of a team space having an indicia indicating a country to modify an advantage or disadvantage movement of a game piece, reflective of competitiveness of the country's national team. None of the references teaches or suggests the limitation. Therefore, claim 42 is patentable over the cited references.

New claims 43-44 depend on claim 42, incorporating its limitations. Therefore, for at least the same reasons, claims 43-44 are patentable over the cited references.

New claim 45 includes the limitations of a team space having an indicia indicating a soccer club to modify an advantage or disadvantage movement of a game piece, reflective of competitiveness of the soccer club. None of the references teaches or suggests the limitation. Therefore, claim 45 is patentable over the cited references.

New claims 46-47 depend on claim 45, incorporating its limitations. Therefore, for at least the same reasons, claims 46-47 are patentable over the cited references.

New claim 48 includes the limitation of team spaces disposed in a colored card zone, and a chance card having an indicia instructing a token occupying one of these teams space be either unconditionally or conditionally removed. None of the references teaches or suggests the limitation. Therefore, claim 48 is patentable over the cited references.

New claims 49-50 depend on claim 48, incorporating its limitations. Therefore, for at least the same reasons, claims 49-50 are patentable over the cited references.

Claim 51 is patentable for at least the same reasons claim 1, 42, 45, or 48 is patentable.

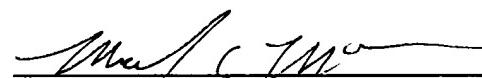
CONCLUSION

In view of the foregoing, Applicant respectfully submits that claims 1, 2, 5-8, 10-16, 18, 21-23, and 40-51 are in condition for allowance. Early issuance of Notice of Allowance is respectfully requested.

Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
Schwabe, Williamson and Wyatt, P.C.

Date: 11/22/04



Mark C McClure, Reg. No. 53,857

Pacwest Center
1211 SW Fifth Ave., Ste 1600-1900
Portland, Oregon 97204
Phone: (503) 222-9981
FAX: (503) 796-2900